

Appl. No. 10/614,733
Amdt. Dated April 20, 2006
Reply to Office Action of February 24, 2005

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed October 20, 2006. In the Office Action, claims 1-19 were rejected under 35 U.S.C. §103. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Applicants have pre-paid two months of Extension of Time (EOT) costs. If third month EOT costs are required, the undersigned attorney authorized a debit to our deposit account as noted on the transmittals accompanying the subject amendment. The RCE has been refilled for clarity purposes. Please apply the RCE fees previously submitted.

Request for Examiner's Interview

The Examiner is respectfully requested to contact the undersigned by telephone at the phone number listed below if after review, such claims are still not in condition for allowance. This telephone conference would greatly facilitate the examination of the present application. The undersigned attorney can be reached at the telephone number listed below.

Rejection Under 35 U.S.C. § 103

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Barkan. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine*, 873 F. 2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Herein, at a minimum, Applicants respectfully submit that the combined teachings of the cited references (Dimpsey and Joy) do not describe or suggest all the claim limitations set forth in independent claims 19.

Again, Applicants timely challenge the Official Notice in accordance with MPEP § 2144.03. It is noted that the Office Action is devoid of any argument directed to the lack of allowability of these claims, besides general statements that storing the coupon data in digital form is inherent, matching the stored information is inherent. Applicants respectfully submit that the matching of each field of the coupon does not occur at the POS system as set forth in page 3 of the Background section of the subject application.

For instance, Barkan does not suggest comparing the manufacturer code from the coupon barcode with a product barcode read by the POS system, *and if a match*, analyzing each field of the coupon barcode, including a value code, an offer code, an expiration code, *and any terms and conditions associated with the coupon barcode*, to verify that a purchased product meets terms set by the coupon barcode. Emphasis added.

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Applicants respectfully request reconsideration of claim 19.

Claims 1-18 and 20-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Barkan in view of Pearlman (US Published Application No. 2003/0233276). Applicants respectfully traverse the rejection in its entirety because a *prima facie* case of obviousness has not been established. Applicants timely challenge the Official Notice reliance made for this rejection in accordance with MPEP § 2144.03.

With respect independent claims 1 and 15, neither Barkan nor Pearlman, alone or in combination, teaches or suggests the operations of (i) uploading *a scanned barcode and a store credit* from a portable scanner, the *store credit* being stored within the portable scanner and *awarded based on participation in a retail store program (RSP)* or (ii) a portable scanner that comprises internal memory to store (i) a plurality of electronic coupons stored as coupon barcodes and (ii) *retail store program (RSP) information including store credit accessible only by the in-store server*. Emphasis added. Store credit is separate and distinct from the value of coupons, which are based on monetary discounts provided by the manufacturer for product purchases. Applicants respectfully request reconsideration of claim 1.

Additionally, with respect to claim 8, neither Barkan nor Pearlman, alone or in combination, teaches or suggests processing of the scanned barcode being a coupon barcode further comprises redeeming of the scanned coupon further comprises *generating a detailed proof of purchase for every coupon redemption transaction, the proof of purchase comprises* (i) a date stamp, (ii) a time stamp, (iii) a retail store location where the coupon was redeemed and aisle location of a product purchased, (iv) an original selling price of the purchased product, (v) a face value of the scanned coupon redeemed, and (vi) additional discounts offered by the retailer. Rather, both Barkan and Pearlman are devoid of any teachings of a proof of purchase as claimed.

With respect to claim 9, Applicants further submit that neither Barkan nor Pearlman, alone or in combination, teaches or suggests an internal memory coupled to the processing unit, where the internal memory comprises a plurality of data storage groupings including (1) *a first data storage grouping being a list of coupons, inaccessible for redemption, that are currently available for a particular geographic region*, and (2) a second data storage grouping being a list of coupons, accessible for redemption, that were scanned and matched with a coupon of the first data storage grouping. This storage grouping is able to control redemption of coupons based on location.

In summary, Applicants respectfully request withdrawal of the §103(a) rejection based on the lack of a *prima facie* case of obviousness.

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Conclusion

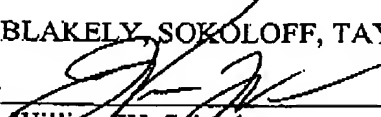
Applicants respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: April 20, 2006

By


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Susan McFarlane

4/20/2006

Date